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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,511	11/14/2000	David K. Gifford	06543-002006	8013

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BELL, BOYD & LLOYD, LLC
PO BOX 1135
CHICAGO, IL 60690-1135

EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/711,511

Applicant(s)

GIFFORD, DAVID K.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This Non-Final Office action is responsive to Applicant's Election filed December 8, 2003.

Applicant has elected claims 1-4 and cancelled non-elected claims 5-22.

Claims 1-4 are presented for examination.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Bush (U.S. Patent No. 5,475,585).

Bush discloses a network sales system comprising:

[Claim 1] a plurality of buyer computers and at least one merchant computer interconnected by a communications network (col. 1, lines 8-27, 56-59 -- Bush's invention is targeted to customers of cable TV, thereby implying that multiple cable customers may access Bush's service via cable transmission; Fig. 1A),

means at each merchant computer for maintaining and providing a database of digital advertisements (Fig. 1A; col. 3, lines 1-20; col. 5, lines 10-19) comprising:

means for storing said digital advertisements, each digital advertisement including a product abstract (Figs. 1A-5, 8; col. 3, lines 52-54; col. 8, lines 3-8 -- The electronically communicated and displayed menu of various artists performing in a selected location is indicative of a database of digital advertisements with corresponding instructions that are programmed to cause the advertisements to be displayed. Also, a brief description, i.e., an abstract, of various products and services may be advertised to a customer),

means for communicating a digital advertisement to a buyer computer over said network in response to a network request from said buyer computer (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8),

means at each buyer computer for requesting, displaying, and responding to digital advertisements (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8) comprising:

means responsive to a user inquiry for selecting a merchant computer and obtaining a digital advertisement for a product from said database of advertisements at said merchant computer (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8),

display means for displaying said advertisement (col. 3, lines 1-20; col. 8, lines 3-16),

purchase means responsive to a user request for communicating a purchase message to said merchant computer (Figs. 1A-5, 8; col. 8, lines 3-16),

account identification means to authorize said purchase message by sending messages into a financial system network (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48),

means, at said merchant computer, comprising:

authorization means to authorize said purchase message by sending messages into a financial system network (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48 -- In one scenario, the merchant computer must submit transaction information to the financial system network in order to provide a cross-check before the financial transaction is verified, as explained in detail in col. 3, line 60 through col. 4, line 10),

fulfillment means to send said product to user conditional on approval of said authorization means (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-

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48; col. 8, lines 13-16, 30-42 -- Ordered tickets or software are delivered to the user after processing payment);

[Claim 3] wherein said account identification means comprises:

means for assembling a payment order (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48),

means for sending said payment order to a network payment system for authorization (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48),

and wherein said authorization means comprises:

means for verifying that said payment order has been previously authorized by said payment system (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48).

Bush discloses an electronic sales system comprising:

[Claim 4] means for storing a database of digital advertisements, each digital advertisement for a product including a program (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8 -- The electronically communicated and displayed menu of various artists performing in a selected location is indicative of a database of digital advertisements with corresponding instructions that are programmed to cause the advertisements to be displayed),

means for communicating a digital advertisement to a buyer computer (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8),

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means at said buyer computer for displaying and responding to said digital advertisement (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8) comprising:

display means for displaying said digital advertisement by executing a portion of said advertisement as a program and performing actions as specified by said program (col. 3, lines 1-10; col. 8, lines 3-16),

purchase means responsive to a user request for communicating a purchase message to a merchant computer (Figs. 1A-5, 8; col. 8, lines 3-16),

means, at said merchant computer, comprising:

fulfillment means to send said product to said user (col. 3, lines 52-54; col. 8, lines 13-16, 30-42 -- Ordered tickets or software are delivered to the user after processing payment).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bush (U.S. Patent No. 5,475,585), as applied to claim 1 above.

[Claim 2] Bush discloses an authorization means at the merchant computer (as discussed in the rejection of claim 1 above); however, Bush does not expressly teach the details of what occurs if it is determined that certain payment information is missing.

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Official Notice is taken that it is old and well-known in the art of financial transactions to request additional information if needed to complete a financial transaction. For example, Bush specifically addresses credit card transactions and it is old and well-known to request additional credit card information when needed. This additional information may include a credit card holder's address, security code, name as exactly printed on the credit card, etc. The request for additional information during a credit card transaction provides added security for the transaction (e.g., verification that the card has not been stolen or is not being used by someone not in possession of the actual card). The limitations of claim 2 are merely directed toward the means for electronically performing such a request for missing information; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Bush's electronic credit card authorization means to incorporate means for communicating a missing payment information request message to said buyer computer to obtain missing payment information, means for receiving said missing payment information from said buyer computer, means for authorizing said purchase message by sending messages into a financial system network, wherein said account identification means at said buyer computer comprises means responsive to said missing payment information request message to query the user for additional payment information and means to send said additional payment information to said merchant computer in order to facilitate the quick and efficient retrieval of additional information needed to complete a credit card transaction, thereby

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providing added security for the transaction (e.g., verification that the card has not been stolen or is not being used by someone not in possession of the actual card).

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 3, and 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 9-11 of U.S. Patent No. 6,195,649. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 3, and 4 of the instant application are anticipated by the limitations recited in the specified claims of the patent.

10. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 18, 49, and 51 of U.S. Patent No. 5,724,424. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because claims 1-4 of the instant application are anticipated by the limitations recited in the specified claims of the patent.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

or faxed to:

(703)305-7687	[Official communications; including After Final communications labeled "Box AF"]
(703)746-7048	[Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.



Susanna M. Diaz
Primary Examiner
Art Unit 3623
January 31, 2004